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EXAMINER	
CHANG, SUNRAY	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DETKEF FISCHER, MARTIN GLASER, OLIVER KAISER, HANS-JURGEN SAUER, THOMAS SCHOCH, RAINER SPEH, MICHAEL UNKELBACH, STEFFEN WAGNER, and HORST WALZ

Appeal 2009-006549
Application 10/763,786[1]
Technology Center 2100

Decided: October 29, 2009

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and JAY P. LUCAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] Application filed January 23, 2004. Appellants claim the benefit under 35 U.S.C. § 119 of European Patent Office (EPO) application 01119041.0, filed 08/07/2001. The real party in interest is Siemens.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1-14 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a process control system that determines a fee based on system use (Spec. 2, ll. 15-21). In the words of Appellants:

> [The] system can be adapted flexibly to the customer's requirements and … is especially designed to reduce the given initial high investment costs, especially the investment costs for the software components of the process control system and the license payments to be made for them.

(Spec. 2, ll. 6-10).

> This is a way of guaranteeing that the customer … must in practice only pay (extra) for those functions of process control system that he is really using.

(Spec. 2, ll. 22-27).

Claim 1 and claim 14 are exemplary:

1. A process control system, comprising:

a processor unit adapted to determine a payment figure from operations running in the process control system regarding the creation or removal of a process control function or regarding a user activity or regarding an execution of an automation function.

14. A method for determining a payment figure in a process control system, comprising:

providing a processor unit adapted to record the creation and/or removal of a process control function and an execution of an automation function;

providing a device adapted to record a user activity; and

determining a payment figure by the processor unit using recorded data of the preceding steps.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mori	US 5,103,392 A1	Apr. 07, 1992
Papadopoulos	US 6,282,454 B1	Aug. 28, 2001
Baker	US 7,035,898 B1	Apr. 25, 2006 (Aug. 9, 2000)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-13 stand rejected under 35 U.S.C. § 103(a) for being obvious over Papadopoulos in view of Mori.

R2: Claim 14 stands rejected under 35 U.S.C. § 103(a) for being obvious over Papadopoulos in view of Mori and further in view of Baker.

Claims 1 and claim 14 are representative. *See* 37 C.F.R. § 41.37 (c) (vii).

Appellants contend that the claimed subject matter is not rendered obvious by Papadopoulos in combination with Mori and Baker because

Mori's proprietors (people who are charging users a fee for using their proprietary software) determine Appellants' claimed "payment figure." (App. Br. 6, bottom to 7, top). Appellants further contend that since these proprietors are not computer parts in Mori's system, the claims are not rendered obvious by the combination of references. (*See id.*) The Examiner contends that each of the claims is properly rejected (Ans. 12, bottom).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Mori discloses Appellants' claim limitation "to determine a payment figure." More specifically, we consider Appellants' contention that proprietors (humans) set a fee to be charged for using software, instead of computer components of Mori's system determining the fee. (*See* App. Br. 6, middle to 7, top.)

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a system and method of determining a fee (the claimed "payment figure") for use of a process control system based on usage. (*See* Spec. 2, ll. 15-18 and 25-28.)

Papadopoulos

2. The Papadopoulos reference discloses an industrial control system (col. 2, ll. 34-35), referred to as "process control system 6" (col. 4, l. 4).

Mori

3. The Mori reference discloses a system containing computer components that generate a fee based on system usage. (*See* col. 6, ll. 47-49.) Mori discloses a "timer portion 133," "I/O processing 132," "use history storage 131," and "payable charge storage." (col. 3, ll. 43-49; Fig. 2). Mori further discloses tables for calculating charges based on usage. (*See* col. 9, 54-62; Fig. 5, elements 411b and 411c.)

Baker

4. The Baker reference discloses a web-based operating program that allows a user to rearrange components of a programmable logic controller (PLC) and save the results for later access and use. (*See* col. 6, ll. 41-43 and 55-60.)

PRINCIPLE OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under 35 U.S.C. § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. § 103(a). The prima facie case is presented on pages 3 to 9 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of claims 1 to 13 under 35 U.S.C. § 103(a) [R1]

Appellants contend that Mori does not disclose the claim limitation "to determine a payment figure," as recited in exemplary claim 1, because proprietors (people, and not computer components of Mori's system) enter a payment figure (*i.e.*, a fee for software use). (*See* App. Br. 6, middle to 7, top.) More particularly, Appellants contend: "[Mori's] proprietors are not part of the system disclosed by Mori. Rather, … the proprietors 'register their programs … [and] obtain accounts of the use of their programs …' … [T]here is no support for contending that the system of Mori would

determine a payment figure." (App. Br. 6, bottom to 7, top; Board's emphasis).

We disagree with Appellants' argument, noting that in the Answer, the Examiner did not cite Mori's proprietors as disclosing the claim limitation "to determine a payment figure." (*See* Ans. 3-9.) We find that the Mori reference discloses a system containing computer components that generate a fee based on system usage (FF#3). Mori discloses a "timer portion 133," "I/O processing 132," "use history storage 131," and "payable charge storage." (*id.*). We find that Mori further discloses tables for calculating charges based on usage (*id.*). Mori's tables disclose that use time data is associated with cost, resulting in a charge similar to the claimed "payment figure." (*See e.g.*, Fig. 5A, elements 411b and 411c.) In light of Mori's disclosures of these elements (*e.g.*, "timer portion 133" and tables) that calculate a fee for software usage, we find unconvincing Appellants' arguments that Mori's proprietors determine Mori's usage fee, as argued above by Appellants. Since Mori discloses a system containing computer components that generate a usage fee (FF#3) (*i.e.*, human proprietors do not determine the fee), the claim limitation "to determine a payment figure" is met. Accordingly, we decline to find error in the Examiner's analysis of claim 1.

Argument with respect to the rejection of claim 14 under 35 U.S.C. § 103(a) [R2]

Independent claim 14 recites "[a] method for determining a payment figure."

Regarding exemplary claim 14, Appellants argue: "[T]here is no support for contending that … Mori would determine a payment figure." (App. Br. 6, bottom to 7, top).

For the same reasons stated above, we find unconvincing Appellants' argument for claim 14. As we stated, since Mori discloses computer components (*e.g.*, "timer portion 133" and tables) for calculating a software usage fee (FF#3) (*i.e.*, a fee not determined by human proprietors), the claim limitation "to determine a payment figure" is met. Accordingly, we find no error.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-14 under rejections [R1 and R2].

DECISION

The Examiner's rejections [R1 and R2] of claims 1-14, respectively, are Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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